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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,107	11/22/2000	Dominik M. Wiktor	3553-111US	6122
7590	04/06/2004		EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C., 1100 NEW YORK SUITE 600 WASSHINGTON, DC 20005-3934			LEWIS, RALPH A	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 04/06/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/721,107	WIKTOR, DOMINIK M.	
	Examiner Ralph A. Lewis	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 03 April 2002.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 5-12 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 5-12 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

### **Objection to the Specification**

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP ' 608.01(o). Correction of the following is required:

The specification must clearly identify what is being referred to with the out of phase terminology.

In response to the present objection, rather than pointing to any particular passage in the specification that provides an antecedent basis for the now critical "out of phase terminology" or even amending the specification to provide for a clear explanation as to what the terminology means or as to what applicant is attempting to claim, applicant provides a lengthy discussion as to what applicant is attempting to claim. It is unclear how such a response would be of any assistance to a person reading a patent (which were to issue from the present application) to reasonably discern what is being claimed as applicant's invention without ordering the whole prosecution history of the application.

### **Rejections Based on Obvious-type Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper tames extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.d. 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 5-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5,133,732. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have found it obvious to have set forth the invention claimed in '732 in the terms of the present claim.

Claims 5-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,113,621. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have found it obvious to have set forth the invention claimed in '621 in the terms of the present claim.

### **Proposed Interference**

Claims 5-12 of this application are asserted by applicant to correspond to claims 1-8 of U.S. Patent No. 6,066,167.

The examiner does not consider applicant's claims 5-12 to be directed to the same invention as that of claims 1-8 in U.S. Patent No. 6,066,167 because claim 1 of '167 requires that "the undulating pattern of each of the cylindrically shape elements being out of phase with the undulating pattern of each of the adjacent cylindrically shaped elements" [emphasis added]. Applicant initially indicated that his "Fig. 7 shows the peaks of the zigzag circumferentially aligned ('in-phase') while Fig. 8 shows the zigzags 'out of phase' with each of the adjacent turns; note the 'phase' of the opposed peaks and valleys at 50 and 48" (applicant's May 21, 2001 amendment and request for interference, page 10, lines 11-14). As pointed out by the examiner, however, applicant's Figure 8, however, shows a "pattern" where the undulations are in phase as one looks along the top and the bottom of the Figure. The connections 50 cause one of the five peaks in each turn to be somewhat askew, however, the other four peaks all remain illustrated in alignment, the overall "pattern" remains in-phase.

Now this time applicant provides an enlarged copy of Figure 1 with a grid drawn on top of it and asserts that Figure 1 illustrates the claimed "out of phase" undulating pattern. The examiner, however, is not persuaded by applicant's new interpretation for several reasons.

First, the examiner finds applicant's application of a flat linear two-dimensional grid to show the shape of a curved three-dimensional object to be misleading and inaccurate. The lines "A" and "B" of the grid provided by applicant are straight, but should be curved to reflect the curved cylindrical shape of the stent and mandrel. The

lines would only be straight if they were longitudinal to or perpendicular to the axis of the stent. It is apparent that if such lines were curved to accurately reflect the curvature of the mandrel and stent then the "out of phase" relationship between the peaks and valleys is no longer present in the Figures.

Second, the grid is drawn at an angle with respect to the axis of the cylinder. If a longitudinally extending wire were attached along the cylinders of the stent (particularly along the top and bottom edges) one would end up with applicant's Figure 7 embodiment which applicant has already declared to "in phase." Applicant clearly indicates that when the peaks of the zigzags are "circumferentially aligned" that they are "in-phase" (applicant's May 21,2001 amendment and request for interference, page 10, lines 11-14)

Finally, the examiner is of the position that the ordinarily skilled artisan when viewing applicant's Figures 1-6 (without the imposed grid) would view the peaks to be "circumferentially aligned" with one another and would most likely conclude that the undulating cylindrically shaped elements are in-phase with all the peaks occurring along the same general longitudinal lines and valleys all occurring along the same general longitudinal lines (just as applicant has concluded when he declared that the Figure 7 embodiment was in-phase). Applicant's position that the reference orientation should be at an angle to the longitudinal axis of the stent rather than along the axis of the longitudinal axis of the stent is counterintuitive and the awkward interpretation is set forth in neither the specification nor claims.

**Rejection based on 35 U.S.C. 112, first paragraph**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As noted above applicant's originally filed specification provides no reasonable basis for the now claimed "each of the turns defining a generally cylindrical body having an undulating pattern of zigzags or waves, each of the turns defining a generally cylindrical body being out of phase with the undulating pattern of each of the adjacent turns"

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(703) 308-0770**. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis  
April 5, 2004

  
Ralph A. Lewis  
Primary Examiner  
*Art 3732*